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Paper No. 7

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
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DEC 05 2002

OFFICE OF PETITIONS

In re Application of
Brucker et al.
Application No. 10/083,711
Filed: February 26, 2002
For: Bifurcated Stent and
Delivery System

DECISION DISMISSING
PETITION UNDER
37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(b), filed on July 9, 2002 (certificate of mailing June 28, 2002), which has been treated as a petition under 37 CFR 1.47(a).¹

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

On February 26, 2002, applicants filed the above-identified application, without an executed oath or declaration, the statutory basic filing fee, and additional claim fees. On April 3, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring a properly signed oath or declaration and payment of the basic filing fees, additional claim fees, and a surcharge for the late filing. In response, on July 9, 2002, applicant submitted, *inter alia*, the present petition, an executed declaration, and an authorization to charge the Deposit Account for the requisite fees.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath

¹ A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lack items (1) and (2) as set forth above.

As to item (1), James M. Urzedowski stated that he mailed letters to inventor, Enrique Malaret, on May 1, 2002, May 23, 2002, and June 4, 2002, requesting that Mr. Malaret sign the Declaration and Assignment that was included with the letters. Mr. Urzedowski further indicated that he was notified by an attorney who claimed to represent Mr. Malaret, who stated that due to an existing disagreement between Mr. Malaret and the assignee, Mr. Malaret refused to sign the Declaration or Assignment.

Upon review, it does not appear that Mr. Malaret was presented with a copy of the application papers, including the specification, claims and drawing. Unless Mr. Malaret was presented with a complete copy of the application papers (specification, claims and drawings), he could not attest that he has "reviewed and understand the application papers" and, therefore, could not sign the Declaration which he was given. Accordingly, applicants failed to show or provide sufficient proof that the nonsigning inventor has refused to sign the Declaration. See MPEP 409.03(d). To establish that the inventor has refused to join in the application, applicants should show that a complete copy of the application papers was presented to Mr. Malaret himself or via his attorney and that he did not respond to the request that he sign the declaration. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events. Statements by a party not present when an oral refusal was made is not acceptable.

As to item (2), applicants have failed to submit a proper oath or declaration in compliance with 37 CFR 1.63. The declaration accompanying this petition does not properly and completely identify the residence (city and either state or foreign), the mailing address or post office address of each inventor. Rather, some of the copies of the declaration state the inventors' names but leave the information as to the residences and mailing addresses blank. A new declaration identifying the complete mailing address and/or residence for each inventor is required.

As per applicant's request, the Deposit Account No. 22-0350 is being charged the following fees: \$110.00 extension of time fee; \$740.00 basic filing fee; \$480.00 claim fees; and a \$130.00 surcharge.

Further correspondence with respect to this matter should be addressed as follows and to the **Attention of Senior Petitions Attorney Christina Tartera Donnell**:

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

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